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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,880	12/30/2005	Janne Jokinen	2835-0151PUS1	9684

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EXAMINER

STANLEY, JANE L

ART UNIT	PAPER NUMBER
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4145

NOTIFICATION DATE	DELIVERY MODE
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04/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/533,880	Applicant(s) JOKINEN, JANNE	
	Examiner JANE L. STANLEY	Art Unit 4145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050505</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the specification includes a graph on page 21 and a graph on page 23. Applicant is reminded that graphs/drawings must be separate from the body of the specification. Furthermore, said graphs are written in French and Applicant is reminded that any text within the drawings should be in English. See MPEP 608.02 V (37 CFR 1.84.)

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: on page 14 the title of table A is spelled 'Blanc'. It is believed this word is meant to be 'Blank'.

Appropriate correction is required.

Claim Objections

3. **Claim 2** is objected to because of the following informalities: claim 2 recites the phrase "from stationary engines and equipment" and it is unclear what use of the word 'from' is intended to mean. It is unclear if this is intended to mean 'compressors from stationary engines and equipment' or if 'stationary engines and equipment' are intended to be a completely separate option in the Markush group. Appropriate correction is required.

4. **Claim 7** is objected to because of the following informalities: the claim is unclear as it recites "claims 1-6 claim 1". It appears the claim was intended to recite only "claim 1," and for the purposes of this office action that is how the claim will be interpreted.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-7** are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 provides for the use of a coolant fluid, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process

applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1 and 5-7** are rejected under 35 U.S.C. 102(b) as being anticipated by Ilves et al. (WO 97/31988).

Regarding claim 1, Ilves et al. teaches use of an aqueous solution (abstract) comprising trimethyl glycine (abstract; pg 3 ln 19-22) as a coolant fluid and/or as a protective fluid (heat transfer/cooling fluid, abstract; pg 3 ln 15-17).

Additionally Ilves et al. discloses said solution used in engine applications (see motor applications, pg 1 ln 10-11).

Regarding claims 5-6, Ilves et al. teaches the claim limitations as set forth above and further teaches use characterized in that:

- the coolant fluid comprises 1 to 60 % by weight of trimethyl glycine as an anhydrate or monohydrate, or salts or derivatives of trimethyl glycine or mixtures thereof (35%, pg 8 ln 18).
- the coolant fluid comprises 20 to 45 % by weight of trimethyl glycine as an anhydrate or monohydrate, or salts or derivatives of trimethyl glycine or mixtures thereof (35%, pg 8 ln 18).

Regarding claim 7, Ilves et al. teaches the claim limitations as set forth above and further teaches use characterized in that the coolant comprises additives (corrosion inhibitors, stabilizing agents, etc. pg 4 ln 6-8).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilves et al. (WO 97/31988) as applied to **claims 1** and **5-6** above, and in view of Oppenländer et al. (DE 19830819 A, see English language equivalent: US No. 6,413,445).

Regarding claims 2-4, Ilves et al. teaches the claim limitations as set forth above however, Ilves et al. does not teach the use of said coolant liquids in either:

- the engine applications are selected from engines used in automobiles, trucks, motorcycles, aircrafts, trains, tractors, generators, compressors, from stationary engines and equipment, marine engines, power systems, industrial engines, electric engines, fuel cell engines and hybride engines;
- internal combustion engines used in automobiles; or
- engines and water pumps with aluminium components.

However, Ilves et al. teaches that trimethyl glycine is used as an alternative to glycols because of their reduced corrosive action and environmental effects as compared to glycols (pg 2 ln 10-31 and pg 3 ln 24-32 and pg 4 ln 18-20).

Oppenländer et al. teaches coolants for use in internal combustion engines (col 1 ln 12-13), especially engines using greater amounts of aluminum alloys (col 1 ln 29). Oppenländer et al. also teaches that common coolant compositions comprising alkylene glycols and water solutions are known to be extremely corrosive to said automotive engines, especially at their high operating temperatures (col 1 ln 18-20). In view of the teachings of Ilves et al. and Oppenländer et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to use trimethyl glycine, as taught by Ilves et al., as an alternative to glycols in coolants for use in internal combustion engines in automobiles (**claims 2-3**) and in engines and water pumps with aluminum components (**claim 4**), as taught by Oppenländer et al., for the purpose of reducing or eliminating the corrosion associated with using alkylene glycol and water based coolant compositions.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE L. STANLEY whose telephone number is (571)270-3870. The examiner can normally be reached on Monday - Friday, 7:30 am - 5:00 pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Basia Ridley can be reached on (571) 272-1453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLS

/Basia Ridley/
Supervisory Patent Examiner, Art Unit 4145